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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,857	10/15/2004	Joachim Weber	2002DE108	6356

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CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER	
GREEN, ANTHONY J	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/511,857	WEBER ET AL.	
	Examiner	Art Unit	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-13 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to why applicant recites "reoxidizing" when a step of oxidizing does not appear to be present. That is, "reoxidizing" suggests that oxidizing was previously performed however this is not present in the claims. Accordingly the claim is confusing.

In claim 7 applicant recites "oxidation" however no oxidation step appears in claim 1. Note that claim 1 recites "reoxidizing".

In claim 10 the phrase "the leuco compound formed" appears to lack proper antecedent basis.

In claim 12 the phrase "high molecular mass organic material" is vague and indefinite as "high" is a relative term.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dietz et al (US Patent No. 5,071,482).

The reference teaches, in example 9, a indanthrene pigment which is subjected to vatting and then oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

6. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dietz et al (US Patent No. 5,264,032).

The reference teaches, in column 3, lines 50+, a process for preparing pigment preparations using a fine dispersion process wherein the fine dispersion may be carried out by a chemical process such as vatting and subsequent reoxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

7. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Urban et al (US Patent No. 5,662,739).

The reference teaches, in column 3, lines 15+ the manufacture of dioxazine pigments by a process of fine division which includes, for example, wet and dry grinding operations, dissolution or suspension in concentrated acids followed by discharge into water, vatting and reoxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

8. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoch et al (US Patent No. 4,189,582).

The reference teaches, in the abstract, column 1, lines 55+, the examples, and the claims, the production of perylene pigments by vatting and oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

9. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoch et al (US Patent No. 4,217,455).

The reference teaches, in column 2, lines, 40+, the examples, and the claims, the production of perylene-3-4,9,10-tetracarboxylic diimide pigments by vatting and oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

10. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoch et al (US Patent No. 4,332,955).

The reference teaches, in the abstract, column 2, lines 32+, the examples, and the claims, the production of tetrachlorothioindigo pigments by vatting and oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the

reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

11. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoch et al (US Patent No. 4,298,534).

The reference teaches, in column 2, lines 20+, the examples, and the claims, the production of bromo-isoviolanthrone pigments by vatting and oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

12. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoch et al (US Patent No. 4,286,094).

The reference teaches, in column 3, lines 21+, the examples, and the claims, the production of perylene-3-4,9,10-tetracarboxylic diimide pigments by vatting and oxidation.

The instant claim appears to be met by the reference. While the reference does not teach the use of the same process, it is the position of the examiner that the resulting product is the same. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Accordingly it is the position of the examiner that since the reference teaches a process of producing a pigment using vatting and oxidation that is different from that claim it is believed that the resulting product is the same.

13. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch et al (US Patent No. 4,217,455 and 4,286,094) in view of Weber et al (US Patent Application Publication NO. US 2001/0016656).

The Hoch et al patents were discussed previously.

Weber et al teach a process for producing perylene-3-4,9,10-tetracarboxylic diimide pigments having advantageous coloristic and rheological properties from crude perylimide pigments by means of a special beadmilling operation with high energy density wherein the beadmilling operation comprises wet-grinding a crude perylimide pigment in a liquid medium in a stirred ballmill operated at a power density of from 1.0 kW per liter of milling space and at a stirrer tip speed of more than 12 m/s under the action of grinding media having a diameter of less than or equal to 0.9 mm, and isolating the resulting pigment.

The instant claims are obvious over the reference. The only differences seen to exist between the instant claims and the primary references (Hoch et al) differs in how the crude pigments are sheared. Since the secondary reference teaches that one may obtain pigments having improved properties using a specific shearing process it would have been obvious to use this process to subject the pigments of the primary references to shearing forces in order to produce a pigment having improved properties. As for the product by process claims (11-13) it is believed that the pigments resulting from the combination of the references would meet these claims absent evidence showing otherwise.

14. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz et al (US Patent No. 5,071,482 and 5,264,032); Urban et al (US Patent No. 5,662,739);

The references were discussed previously.

While the references do not recite a specific example wherein the pigment that is vatted and oxidized is used to pigment a high molecular mass organic material, the references teach that the pigments may be used to pigment high molecular mass organic materials. Accordingly claims 12-13 are rendered obvious.

15. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch et al (US Patent No. 4,189,582 and 4,217,455).

The references were discussed previously. While the references do not recite a specific example wherein the pigment that is vatted and oxidized is used to pigment a high molecular mass organic material, the references teach that the pigments may be used to pigment plastics such as printing inks (see column 4, lines 58-61 of 4,189,582 and column 2, lines 40-45 of 4,217,455). Accordingly claims 12-13 are rendered obvious.

16. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch et al (US Patent No. 4,332,955).

The reference was discussed previously. While the reference does not recite a specific example wherein the pigment that is vatted and oxidized is used to pigment a high molecular mass organic material, the reference teaches that tetrachlorothioindigo pigments may be used to pigment plastics and surface coatings (see column 1, lines 10-20). Accordingly claims 12-13 are rendered obvious.

17. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch et al (US Patent No.4,298,534).

The reference was discussed previously. While the reference does not recite a specific example wherein the pigment that is vatted and oxidized is used to pigment a high molecular mass organic material, the reference teaches that bromo-isoviolanthrone pigments may be used to pigment plastics and printing inks (see column 1, lines 10-17). Accordingly claims 12-13 are rendered obvious.

18. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch et al (US Patent No.4,286,094).

The reference was discussed previously. While the reference does not recite a specific example wherein the pigment that is vatted and oxidized is used to pigment a high molecular mass organic material, the reference teaches that perylene pigments may be used to pigment plastics and surface coatings (see column 1, lines 10-13). Accordingly claims 12-13 are rendered obvious.

Information Disclosure Statement

19. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the

application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609 subsection III. A(1) states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report except for those having US equivalents have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609 subsection III. C(1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
July 22, 2005